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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,221	01/30/2004	Joseph A. Zupanick	067083.0214	9602
26231	7590	03/22/2006		
FISH & RICHARDSON P.C. P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER DANG, HOANG C	
			ART UNIT	PAPER NUMBER
			3672	
DATE MAILED: 03/22/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/769,221	Applicant(s) ZUPANICK, JOSEPH A.	
	Examiner Hoang Dang	Art Unit 3672	

- The MAILING DATE of this communication appears on the cover sheet with the correspondence address -
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16 is/are allowed.
- 6) ☒ Claim(s) 1-4, 8, 10 and 15 is/are rejected.
- 7) ☒ Claim(s) 5-7, 9 and 11-14 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------------------------------------------------------------------------|----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/17/04; 3/8/04; 9/2/04; 9/17/04;</u> | 6) <input type="checkbox"/> Other: ____ |

Handwritten: 11/18/04; 2/7/05; 3/11/05; 8/23/05 and 11/11/05

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 8, 10 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Henley (col. 1, lines 37-44; col. 3, lines 18-23; col. 4, lines 5, 6, 17-21, 25-30, 55-61, 67-70; col. 5, lines 2-8; column 2, lines 34-49 and column 3, lines 6-10).

Henley discloses a method for testing a partially formed well (col. 5, lines 6-8), comprising:

forming a first well bore intersecting a subterranean formation (4), the first well bore comprising a portion of a well and having a first configuration (column 4, lines 6-11);

testing (column 4, lines 17-20) a production characteristic (column 4, lines 5-6) of the subterranean formation through the first well bore in the first configuration;

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reconfiguring (column 4, lines 20-21 and 25-28) the first well bore to a second configuration disparate from the first configuration;

testing the production characteristic (column 4, lines 28-35) of the subterranean formation through the first well bore in the second configuration; and

planning further formation of the well based on testing of the subterranean formation through the first wellbore in the first and second configurations (column 2, lines 34-49 and column 3, lines 6-10)

It is noted that the step of “planning further formation of the well based on testing of the subterranean formation through the first well bore in the first and second configurations” does not distinguish from the Henley reference which discloses in column 2, lines 40+ that “[O]ne of the outstanding advantages of the process of my invention is that valuable information of the type required to ascertain whether large-scale flooding operations should be conducted can be determined under natural reservoir conditions within a relatively short time.” and in column 3, lines 6-10 that “[t]his information then will indicate how much additive will be needed for the main flooding operation in which the main reservoir volume, as a result of other tests, can be established.” In any event, one of ordinary skill in the art would have readily recognized that if the results of the test would be poor the formation would not be further exploited and in the opposite case more boreholes would be performed.

4. Claims 1, 2, 4, 10 and 15 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Berger et al (US 6,581,455) (column 5, lines 40-44; column 8, lines 1-10; column 11, lines 10-36; column 16, lines 19-20; column 18, lines 38-55; column 21, lines 15-23; and column 19, lines 26-28).

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It is noted that in Berger et al, the wellbore is reconfigured every time when the drilling is resumed after a test. Berger et al also disclose in column 19, lines 26-28 that “[t]he data may then be used to optimize the drilling and the completion of the well.”

Allowable Subject Matter

5. Claims 5-7, 9 and 11-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claim 16 is allowed.

Conclusion

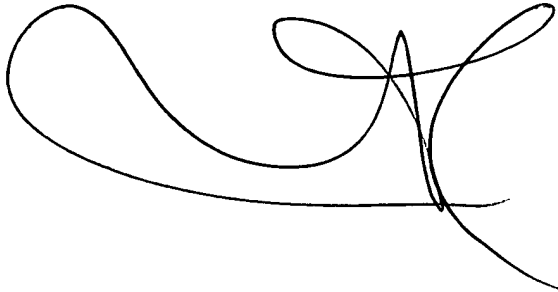
7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang Dang whose telephone number is 571-272-7028. The examiner can normally be reached on 9:15-5:45 Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Hoang Dang
Primary Examiner
Art Unit 3672

A handwritten signature in black ink, consisting of a large, sweeping loop on the left and a more complex, stylized set of loops on the right, ending in a long, thin tail stroke that extends downwards and to the right.